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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,940	06/07/2005	Jurg Haase	HU/1-22812/A/PCT	6888
324	7590	05/03/2007	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			NOLAN, JASON MICHAEL	
PATENT DEPARTMENT			ART UNIT	PAPER NUMBER
540 WHITE PLAINS RD			1626	
P O BOX 2005			MAIL DATE	
TARRYTOWN, NY 10591-9005			DELIVERY MODE	
			05/03/2007 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/537,940	HAASE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason M. Nolan, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 February 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-23,26,27,29 and 30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1,22,23,26,27 and 30 is/are allowed.  
 6) Claim(s) 2,18-20 and 29 is/are rejected.  
 7) Claim(s) 3-5,7-17 and 21 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1.) Certified copies of the priority documents have been received.  
 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1626

## DETAILED ACTION

**Claims 1-5, 7-23, 26, 27, 29 & 30** are pending in the instant application, of which **Claims 1, 5, 9, 10, 22 & 23** are currently amended. **Claims 6, 24, 25 & 28** are canceled and no new claims are presented.

### *Response to Amendment*

Applicant's amendments, see Amendment – After Non-Final Rejection, filed 02/21/2007, with respect to **Claims 1, 5, 9, 10, 22 & 23** have been fully considered and are entered. The rejection of **Claims 1-5, 26, 29 & 30** has been withdrawn. However, new rejections are herein.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 2, 18, 19 & 20** recite the limitation "R<sub>1</sub> and R<sub>2</sub> are selected from hydrogen" in the definition of formula (I). However, formula (I) in **Claim 1** does not allow for a hydrogen atom on R<sub>1</sub> or R<sub>2</sub>. Further, in **Claim 2**, when n<sub>1</sub> is 1, R<sub>3</sub> is not limited to a heterocyclic radical, as it is in parent **Claim 1**. There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

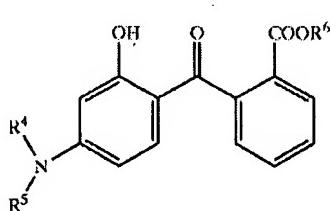
- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claim 29** is rejected under 35 U.S.C. 102(a) as being anticipated by

Heidenfelder et al. (*US Patent 6,488,915 12/03/2002*). Taught in the patent is UV-absorber-dispersion compositions comprising hydroxybenzophenones according to formula II, below, (see columns 2 or 20 of the '915 patent), wherein R<sup>6</sup> can be hydrogen, alkyl, or cycloalkyl; and R<sup>4</sup> & R<sup>5</sup> can be hydrogen, alkyl, cycloalkyl or taken together to form a ring.

**20**

Ba) hydroxybenzophenones of the formula II



in which the substituents, independently of one another, have the following meanings:

R<sup>4</sup> and R<sup>5</sup> are hydrogen, C<sub>1</sub>-C<sub>12</sub>-alkyl, C<sub>3</sub>-C<sub>10</sub>-cycloalkyl, where the substituents R<sup>4</sup> and R<sup>5</sup> may, together with the nitrogen atom to which they are bonded, form a 5- or 6-membered ring and

R<sup>6</sup> hydrogen, C<sub>1</sub>-C<sub>12</sub>-alkyl, C<sub>3</sub>-C<sub>10</sub>-cycloalkyl;

***Claim Objections***

**Claim 29** is objected to because of the following informalities: the line starting "n<sub>1</sub> is" is missing the number 3; it should read: "if n<sub>1</sub> is 3.". Appropriate correction is required.

**Claims 3-5, 7-17 & 21** are objected to as being dependent upon a rejected base

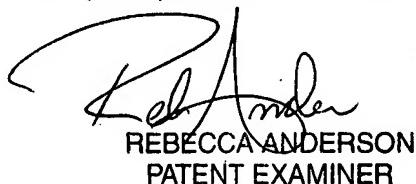
**Claim 1**, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M<sup>c</sup>Kane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.  
Examiner  
Art Unit 1626



REBECCA ANDERSON  
PATENT EXAMINER



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Date: April 18, 2007